



Board of Appeals
188/167

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTHONY MAGLICA

Appeal No. 97-3131
Application 07/411,576

APPLICANT'S SUPPLEMENTAL REPLY TO THE ORDER TO SHOW CAUSE

Serial Number 07/411,576
Filing Date: 09/22/89
Appellant: Anthony Maglica
Examiner: M.H. Tung, A.U. 2901

Board of Patent Appeals and Interferences
Hon. Commissioner for Patents
Washington, D.C. 20231

Sirs:

This Supplemental Reply addresses the Examiner's RESPONSE TO
APPELLANT'S REPLY TO THE ORDER TO SHOW CAUSE ("Response") mailed
August 1, 2001.

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BOARD OF PATENT APPEALS
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CERTIFICATE OF HAND DELIVERY

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being hand delivered on the date shown below to the Commissioner for Patents, Washington, D.C. 20231.

September 4, 2001
Date of Delivery

Robert L Campbell Jr
Name of Person Delivering Paper
Robert L Campbell Jr
Signature of Person Delivering Paper

The Order To Show Cause, mailed December 1, 1998, stated that the Examiner had imposed new grounds of rejection in the Advisory Action dated November 12, 1996, that the new grounds were repeated in the Examiner's Answer dated February 21, 1997, and that Appellant failed to address the new grounds. However, the Examiner in her Response argues in essence that in fact there were no new grounds in the Advisory Action or in the Examiner's Answer, and that the outstanding 35 U.S.C. § 112, first paragraph, rejection actually continues from the final rejection leading to the prior appeal no. 93-0363. (Response at p. 3-4.)

While there is no dispute that the claimed invention has been rejected under 35 U.S.C. § 112, first paragraph, since the very first office action, the record makes abundantly clear that the grounds of that rejection set forth at page 4 of the Examiner's Answer are in fact new. The record also makes clear that Appellant's amendment filed September 5, 1996 did not necessitate the additional grounds of rejection as the Examiner so forcefully argues in her Response. (See Response at p. 3-4.) Rather, the Examiner could have previously asserted the new grounds of rejection, but simply did not. Indeed, it was the Examiner's failure to timely raise the new grounds followed by her subsequent failure to adhere to applicable procedures with respect to raising new grounds of rejection in an Answer that significantly contributed to, if not entirely caused, the current state of affairs. Appellant should not be made to pay the ultimate price--dismissal of the present appeal--under such circumstances.

A dismissal of the present appeal would be particularly prejudicial. As stated at p. 5 of the Response, "the main dispute which has been at the heart of the application since its inception" in 1989 has been the shape of the flashlight head. However, the

Appeal re-mailed October 19, 1998, in Appeal No. 95-4085.)¹ The same evidence the Board found persuasive in that Appeal has been entered in the record in this case and fully discussed in Appellant's Appeal Brief. As a result, the only issues remaining in this appeal are the two new grounds that the Examiner raised for the first time after Appellant's Appeal Brief was filed September 5, 1996, yet could have been raised years earlier, and which have been shown to be totally without merit in Appellant's Response to the Order to Show Cause.

The Examiner first raised these new grounds in the Advisory Action mailed November 12, 1996. As set forth in the Advisory Action and the Examiner's Answer, the new grounds of rejection relate to two points of new matter allegedly added by Appellant's September 5, 1996 amendment. The alleged new matter is identified as follows:

a) The smooth portion of the barrel between the threaded end (bulb end) and the knurled barrel is proportionally longer than shown in the original formal and the original mechanical drawings.

b.) In Fig. 3, the distance between the outermost concentric circle and the next concentric circle toward the inside is proportionally wider than in the original formal or the original mechanical drawings. Although applicant asserts that this is for consistency with the proportions of the flashlight head to the barrel and to the threaded end (shown in Figs. 1 and

¹ A copy of the Boards's second Decision on Appeal (Paper No. 49), which was re-mailed October 19, 1998, in Appellant's companion application 07/410,965 is being attached hereto as the PTO has been unable to locate Appellant's companion application for over a year.

2), the flashlight head in the new drawing is proportionally wider than in the original disclosure.

(Id.)

One need only review the September 3, 1996 Substitute Declaration of Gerald R. Parker ("Substitute Parker Declaration"), which was submitted with the September 5, 1996 amended drawing, to conclude that the new grounds were not necessitated by Appellant's amendment. The Substitute Parker Declaration attaches as Exhibits A, B, and C, respectively, the following: figures 1-4 submitted to the PTO with the Response Pursuant to 37 C.F.R. 1.196(b)(1) mailed August 23, 1993; figures 1-4 showing proposed drawing changes to Exhibit A and which was submitted with an Amendment After Final filed February 27, 1996; and figures 1-4 submitted September 5, 1996, and which are currently on appeal. In each of these drawings the smooth portion of the barrel between the threaded end and the knurled portion of the barrel has remained the same while the other linear dimensions of the claimed flashlight design have also remained the same or increased slightly. In fact, the linear dimension of the smooth portion has not changed since the 1/7/92 drawings considered in the first appeal, while the other linear dimensions of the claimed flashlight design have remained the same or increased slightly. Similarly, the diameter of the flashlight head in Fig. 3, which is represented by the outermost circle in each of these drawings, has not changed. Nor has the diameter of the barrel changed in these drawings so as to alter the proportionality between the head and barrel. And with respect to the next concentric circle in Fig. 3, if anything, it has a slightly larger diameter in the September 5, 1996

drawings than in the two earlier sets of drawings attached to the Substituted Parker Declaration, or the 1/7/92 drawings reviewed in the first appeal.

The record, therefore, clearly shows that the Examiner could have raised the two new grounds of rejection in either the December 5, 1995 Final Office Action, which is currently being appealed, or the Advisory Action mailed March 19, 1996. In both instances, however, the Examiner failed to raise these new grounds. Instead, they were not raised until after Appellant had already filed an appeal brief in the instant appeal. Indeed, because the September 5, 1996 drawings have not changed with respect to the points now complained of from the January 7, 1992 drawings reviewed by the Board during the first appeal, the Examiner could have addressed these issues in connection with the first appeal.

The fact that Appellant's September 5, 1996 Amendment did not necessitate the new grounds of rejection is also evidenced by the Examiner's entry of Appellant's Amendment. Had Appellant's Amendment necessitated the new grounds, the Examiner would have been precluded from entering Appellant's substitute drawing. Manual of Patent Examining Procedure ("MPEP") § 1207 at p. 1200-12 (Rev. 2, July 1996) ("Of course, if the amendment necessitates a new search, raises the issue of new matter, . . . or otherwise introduces new issues, it will not be entered.") Thus, if the Examiner believed that the Amendment after final introduced new issues, the Examiner was prohibited from entering it. (Id.)

Further, if the Examiner believed that the Appellant's Appeal Brief failed to respond to any outstanding ground of rejection, the Examiner was obligated to notify Appellant and provide a 1-month period to correct the defect by filing a supplemental

brief. MPEP § 1206 at p. 1200-6, -9 (Rev. 2, July 1996). No such notice was provided. Indeed, none of the grounds on which the 35 U.S.C. § 112, first paragraph, rejection was based in the final Office Action mailed December 5, 1995 or in the Advisory Action mailed March 19, 1996 were asserted by the Examiner on Appeal. Rather, the only grounds relied on were those newly asserted in the Advisory Action mailed November 12, 1996. Thus, Appellant's September 5, 1996 Amendment was effective in overcoming all of the previously stated 112 grounds.

The Examiner also failed to properly raise the new grounds for rejection in the Examiner's Answer. First, under the procedures applicable at the time, the Examiner was required to review the new grounds with her supervisory primary examiner (SPE) and obtain her SPE's signature. MPEP § 1208.01 at p. 1200-20, -21 (Rev. 2, July 1996). The record does not reflect that either of these requirements were satisfied in the instant case. Furthermore, if the decision is made to introduce new grounds of rejection in the Examiner's Answer, rather than by reopening ex parte prosecution, the Examiner is required to clearly identify the new grounds. Id. This requirement was established so that the Board and Appellant are provided with clear notice when the Appellant is required to file a reply to avoid dismissal. Id. at §§ 1208.01, 1208.03. Such a policy is clearly sound and is designed to avoid the very circumstances presented here. Indeed, the applicable MPEP guidelines at the time the Examiner's Answer was filed only authorized dismissal of an appeal for failing to timely file a reply brief when an examiner's answer expressly stated that it included a new ground of rejection. Id. at § 1208.03.

The Examiner in this case had no authority to impose a new ground of rejection without the review and signature of her SPE, or to enter and reject subject matter thought to be new, at any time after the Appeal Brief was filed on September 5, 1996. Applicant cannot now be faulted, and should not now be prejudiced, for not addressing the merits of an ultra vires rejection that the Examiner failed to properly identify in the Examiner's Answer as constituting a new ground of rejection. Applicant had every right to, and did in fact, expect that no (prohibited) new grounds were being added after the Appeal Brief was filed, as none were identified in the Examiner's Answer.

Rather than wait for the Examiner to set the one-month period to which appellant is entitled under MPEP § 1206 (Rev. 2, July 1996), appellant herewith submits a Reply Brief addressing the new grounds of rejection. The Examiner should now enter the Reply Brief and return the case to the Board for decision.

Accordingly, the appeal should proceed and be decided on the merits. Or, at the very least, the Board should return the defective Examiner's Answer to the group director's office for preparation and filing of a properly reviewed and signed substitute Examiner's Answer. MPEP §1208.01 (Rev. 2, July 1996, page 1200-20) ("The Board will return to the group director's office any answer containing . . . a new ground of rejection, where such answer does not bear the supervisory primary examiner's signature.").

To the extent necessary to have the appeal heard, applicant hereby requests reinstatement of the appeal under 37 CFR § 1.193(b)(2)(ii). However, the request is not believed necessary, given the discussion above. To the extent that such reinstatement


request is necessary for hearing the appeal, the Reply Brief submitted herewith will serve as the Supplemental Brief contemplated by 37 CFR § 1.193(b)(2)(ii).

The Commissioner is hereby authorized to charge any fees necessary in connection with this Supplemental Reply, or in connection with the accompanying Reply Brief, to Lyon & Lyon LLP's **Deposit Account No. 12-2475**.

Respectfully Submitted,

LYON & LYON LLP

Dated: _____

By 
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THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 49

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTHONY MAGLICA

OCT 19 1998

PAT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 95-4085
Application 07/410,965¹

HEARD: September 16, 1998

MAILED

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before McCANDLISH, Senior Administrative Patent Judge, and STAAB,
and NASE, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of the following design claim under 35 U.S.C. § 112, first paragraph:

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U.S. PROSECUTION

¹ Application for patent filed September 22, 1989. According to appellant, the application is a continuation of Application 07/356,361, filed May 23, 1989, which is a continuation of Application 07/222,378, filed July 19, 1988, which is a continuation of Application 07/034,918, filed April 6, 1987, now abandoned, which is a continuation of Application 06/828,729, filed February 11, 1986, now Patent No. 4,658,336, granted April 14, 1987, which is a continuation of Application 06/648,032, filed September 6, 1984, now Patent No. 4,577,263, granted March 18, 1986.

Request for Reconsideration due: November 19, 1998
Notice of Appeal or Civil Action due: December 19, 1998

BEST AVAILABLE COPY

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Application 07/410,965

The ornamental design of a flashlight as
shown and described.

Copies of the two sheets of drawings containing Figures 1-6 and representing the subject matter now claimed are attached to the examiner's answer (mailed March 24, 1995) as appendix A. The current description of these drawings is appended to this decision.

BACKGROUND

The instant application was filed as a continuation of appellant's utility application Serial No. 356,361 under 37 CFR § 1.60. As a result of amendment C (Paper No. 12) filed May 29, 1991, the instant application is now stated to be a division of the earlier filed utility application Serial No. 356,361.

Utility application Serial No. 356,361, as evidenced by footnote 1, is the last of a long series of utility applications of overlapping copendency, commencing with appellant's first filed utility application Serial No. 648,032 filed September 6, 1984.

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The present appeal is the second appeal in the instant application.² The first appeal resulted in the Board's decision (Paper No. 27) mailed July 30, 1992.

THE FIRST BOARD DECISION

In the first Board decision (Paper No. 27) in this application, a merits panel of this Board affirmed the examiner's rejection of the appealed claim under 35 U.S.C. § 103, and pursuant to 37 CFR § 1.196(b), entered two new grounds of rejection, one under the first paragraph of § 112, and the other under the second paragraph of § 112. In addition, the Board designated its affirmance of the § 103 rejection as a new ground of rejection under 37 CFR § 1.196(b) in view of the Board's reasons supporting the rejection.

With regard to the § 103 rejection, the merits panel stated on page 3 of the first Board decision:

The only argument supporting patentability over the applied patents is that the patents do not qualify as prior art because appellant is entitled under the provisions of 35 USC 120 to the benefit of the filing date of

² A second appeal is also pending in appellant's companion design application Serial No. 411,576, which is also stated by amendment to be a division of parent application Serial No. 356,361.

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appellant's first filed utility application Serial No. 648,032, that filing data being earlier than the effective dates of the Maglica and Huang patents. See pages 1 and 2 of appellant's main brief.

Appellant does not otherwise question the rejection of the appealed claim if the present design application is not accorded the benefit of the filing date of appellant's utility application Serial No. 648,032. Therefore, a detailed analysis of the references and the application of those references is not necessary. See In re Ahlbrecht, 435 F.2d 908, 168 USPQ 293 (CCPA 1971).

The merits panel in the first Board decision ruled that the instant application was not entitled to the benefit of the filing date of any of the prior utility applications under 35 U.S.C. § 120 because of certain differences between the claimed subject matter (i.e., drawings and accompanying description) pending in the instant application at the time of the first decision and the disclosure as originally filed in each of the prior utility applications as discussed in detail on pages 4-27 of the first decision. These differences are summarized on page 28 of the first Board decision as follows:³

³ In this and other quotations from the first Board decision, the reference characters bearing the prefix "Bd" followed by a reference numeral (e.g., Bd 1) are reference characters applied by the merits panel to copies of various drawings in the appendices to the first Board decision to identify certain lines and other illustrated design features. The same reference characters are used in the text of the instant decision.

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(1) the shape of the flashlight head as shown in Figure 1 and the deletion of the parting line Bd 1, (2) the description that band Bd 16 on the head is knurled, (3) the shape of the end cap surfaces Bd 10, Bd 13 and Bd 14 in Figures 3 and 6 and (4) the knurled pattern Bd 15 of the barrel portion of the flashlight as shown in Figures 1 through 4 of the application.

With regard to the new ground of rejection under the first paragraph of § 112, the merits panel held that the disclosure as originally filed in the instant application lacked support for the claimed design (see page 28 of the first Board decision). In particular, the Board stated:

Considering the new rejection under the first paragraph of §112, the disclosure as originally filed in the instant application does not support the claimed design as currently shown and described (see our Appendices I and II) for the same reason that the originally filed '032 utility application does not support the currently claimed design. The reason for this is that the specification and drawings as originally filed in the instant application are merely photocopies of the specification and drawings as originally filed in the '032 utility patent application.

The new ground of rejection under the second paragraph of § 112 involved an inconsistency between Figures 7-12 and Figures

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13-18 (all of which were pending at the time of the first Board decision) as discussed on page 29 of the first Board decision.

PROSECUTION SUBSEQUENT TO
THE FIRST BOARD DECISION

In response to the new grounds of rejection entered under 37 CFR § 1.196(b) in the first Board decision, appellant elected the option of prosecuting further before the examiner. In the first amendment (Paper No. 30, filed October 5, 1992) following the Board's first decision, appellant canceled the description for Figures 5 through 18 and replaced all of the drawings with a single sheet of drawings containing just a perspective view (Figure 1), a side elevational view (Figure 2), a bottom plan view (Figure 3) and a front elevational view (Figure 4) of the flashlight design. This amendment effectively canceled Figures 7 through 18 which were pending at the time of the first Board decision, as well as the two Figures showing the top plan view of the flashlight and the rear elevation of the tail cap (originally labeled Figures 3 and 6, respectively) which were also pending at the time of the first Board decision.

In the office action responding to the amendment of October 5, 1992, namely the final office action mailed December 29, 1992 (Paper No. 31), the examiner withdrew the Board's rejection under

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the second paragraph of § 112 because the issue of indefiniteness became moot with the cancellation of Figures 7 through 18 (see page 2 of Paper No. 31). The examiner also observed on page 2 of this final office action that the textured pattern on the barrel portion in new Figures 1 through 4 as filed on October 5, 1992 conformed to the textured pattern shown in Figure 1 of the original drawings, thus eliminating this design feature as a source of new matter. In addition, the examiner noted on page 2 of this office action that the new matter issues pertaining to the tail cap were rendered moot as a result of the cancellation of the top plan and rear elevation views as discussed supra. It also appears that the examiner considered that the new matter issues pertaining to the description of the textured patterns on the barrel and the head band as being knurled have been overcome by the amendments to the description of the drawings.

In the office action dated December 29, 1992, the examiner nevertheless maintained the Board's rejection under the first paragraph of § 112 mainly on the ground that the shape of the flashlight head in new drawings filed on October 5, 1992 still differed from the shape of the head in the drawings as originally filed. In this office action the examiner also introduced a new rejection under the first and second paragraphs of § 112 on the

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ground that the design was now "incomplete" (Paper No. 31, page 4) because of the cancellation of the top plan and rear elevation views.

In response to the final office action dated December 29, 1992, appellant filed an amendment on May 3, 1993 with drawings re-introducing the top plan view (Figure 5) and the rear elevation view (Figure 6) to overcome the examiner's § 112 rejection based on incompleteness. As a result of this amendment, the examiner withdrew the rejection based on incompleteness (see answer, page 1), but reinstated the position under the first paragraph of § 112 that the illustrated configuration of the tail cap (referred to as the "end cap" in the examiner's answer) in the newly added Figures 5 and 6 was not supported by the drawings as originally filed in the instant application.

In addition to the foregoing amendments, appellant filed the declarations of Messrs. Siegel and Miller on October 5, 1992 following the Board's first decision to rebut the examiner's rejection under the first paragraph of § 112. In addition, the declarations of Messrs. Jones, Weiss, and Parker were also filed following the Board's first decision, but none of these declarations is relied upon to rebut the standing rejection.

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THE STANDING REJECTION

The appealed design claim stands rejected as follows:

The following ground of rejection is applicable to the appealed claim. The claim is rejected under 35 U.S.C. 112, first paragraph, for new matter. The disclosure as originally filed in the instant application lacks support for the presently claimed design as described in the newly amended drawings, specifically for the following features: (1) the shape of the flashlight head as shown in Figure 1 and the deletion of the contour line on the flashlight head, (2) the description of the band on the flashlight head as knurled, (3) and the shape of the end cap surfaces.

Although the merits panel of this Board expressly designated its affirmance of the examiner's prior § 103 rejection as a new ground of rejection under 37 CFR § 1.196(b) in the first Board decision, the examiner in the ensuing prosecution did not carry the § 103 rejection forward in any of the office actions following the first Board decision or the current examiner's answer. Therefore, on the record, we must assume that for some unstated reason, the prior § 103 rejection has been withdrawn. Accordingly, the only issue before us is the propriety of the examiner's rejection under the first paragraph of § 112.

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DISCUSSION

In design cases, as in utility cases, the test for compliance with the written description requirement in the first paragraph of § 112 is whether the disclosure as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter. In re Daniels, 144 F.3d 1452, 1456, 46 USPQ2d 1788, 1790 (Fed. Cir. 1998). In a design case, the drawings of the illustrated design are viewed in terms of the written description requirement of § 112. Id. Accordingly, the design shown in the pending drawings and constituting the later claimed invention must be illustrated or otherwise described in the application disclosure as filed. See, generally, Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). In the present case, we agree with the examiner that the design illustrated in the pending drawings is not supported by the drawings and other disclosure as originally filed in this application, although not for all of the reasons stated by the examiner.

As noted supra, the drawings originally filed in this application are photocopies of the penciled drawings originally filed in appellant's '032 utility application. All of these original drawings in the present case have since been canceled

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and have been ultimately replaced by the pending drawings containing Figures 1-6 shown in appendix A of the examiner's answer.

With regard to the tail cap illustrated in Figures 5 and 6 of the pending drawings, the Parker declaration correctly notes on page 2 thereof that the only difference between Figures 3 and 6 pending at the time of the first Board decision and the currently pending Figures 5 and 6 resides in the spacing of the lines defining the textured pattern on the intermediate barrel portion. In fact, Figure 6 (the rear elevation of the flashlight) in the pending drawings is the same as the prior Figure 6 which was pending at the time of the first Board decision. Therefore, the following findings and conclusions made in the first Board decision with regard to the tail cap are applicable and are adopted here:

A separate photocopy of the sheet containing Figure 6 of the instant design application is provided in our Appendix VII. To this illustration of Figure 6 in Appendix VII, we have added certain reference characters to identify various lines and surfaces as will be discussed infra.

In Figure 6 of the instant design application, a tab corresponding to the tab 29 in Figures 1 and 2 of the '032 utility application is shown to project rearwardly

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along a carved out region of the tail cap 22 of the flashlight. We have added these reference numerals to the showing of Figures 1 through 4 and 6 in our Appendix VII.

In Figure 6, tab 29 is shown to terminate at a lower edge of the carved out tail cap region. We have marked this edge as Bd 9 in Appendix VII. The back face of the tail cap below the edge Bd 9 is shown in the instant design application drawings to be planar as evidenced from Figures 2 through 4 as well as Figure 6 of the instant design application. We have marked this back face of the tail cap by the reference character Bd 10.

The only showing of this portion of the rear face of the tail cap in the drawings as originally filed in the '032 utility application, however, is in Figure 2 which is longitudinal section taken along Figure 1 of the utility application drawings. There is nothing, however, in Figure 2 or Figure 1 of the original utility application drawings to show that the back face Bd 10 is planar throughout the entire region bounded edge Bd 9 and the cylindrical parameter Bd 11 of the tail cap. So far as the original utility application drawings are concerned, the shape of the back face Bd 10 of the tail cap is not disclosed and therefore may have cavities or similar formations which we have shaded and marked by the reference character Bd 12 in the photocopy of Figure 6 in Appendix VII.

In view of the foregoing, the disclosure in the '032 utility application does not support a showing of the back face Bd 10 of the tail cap as being planar since it may well have other shapes, such as shapes with the cavities Bd 12 as discussed supra.

Furthermore, there is no disclosure in the '032 utility application to support the showing of the tail cap in Figure 3 of the instant design application. In particular,

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there is no support in the disclosure of the '032 utility application for the shapes of the surfaces which we have marked as Bd 13 and Bd 14 in Figure 3 of our Appendix VII. The reference character Bd 13 represents the right hand side face of the rearwardly extending tab 29, and the reference character Bd 14 represents the tail cap surface portion extending to the right of the tab 29 above the edge Bd 9.

As evidenced from Figure 3 of the instant design application drawings, the shape of the tail cap is shown to be symmetrical about a plane containing the longitudinal axis of the flashlight and medially intersecting the tab 29. The disclosure in the original '032 utility application does not support such a showing.

Relating the foregoing findings to the pending drawings and utilizing the same reference characters applied to the photocopy of the drawings in appendix VII of the first Board decision, the drawings as originally filed in the instant application do not provide support for illustrating the back face Bd 10 of the tail cap as being planer throughout the entire region bounded by edge Bd 9 and the cylindrical parameter Bd 11 because the back face of the tail cap may well have cavities (marked Bd 12 in Appendix VII of the first Board decision) or small indentations or even surface markings. As far as the originally filed drawings are concerned, the shape of the tail cap back face (marked Bd 10 in

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appendix VII of the first Board decision) is not shown or otherwise disclosed.

Furthermore, there is no disclosure in the drawings originally filed in the instant application to support the showing of the tail cap in Figure 5 of the pending drawings. In particular, there is no support in the originally filed drawings for the shapes of the surfaces marked Bd 13 and Bd 14 in Appendix VII of the first Board decision. In addition, the drawings as originally filed in the instant application provide no support for illustrating the tail cap as being symmetrical about a plane containing the longitudinal axis of the flashlight and medially intersecting the tab 29 as shown in Figure 5 of the pending drawings.

With regard to the tail cap, appellant argues on page 12 of the main brief that the shape of the tail cap illustrated in the pending drawings is supported by "the fact that the flashlight is of a symmetrical nature." In support of this position, appellant relies on the Siegel and Miller declarations (see page 13 of the main brief). Both of these declarants, using virtually identical language, state that it would be expected that the planar back face of the tail cap as partially shown in Figure 2 of the

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originally filed drawings would extend throughout the region of the tail cap as illustrated in Figure 6 of the pending drawings. Both of these declarants also state in virtually identical language that because of the symmetry of the flashlight in the originally filed drawings, it would be expected that the shapes of the surfaces designated by the reference characters Bd 13 and Bd 14 would be the same as the corresponding surfaces on the other side of tab 29.

We are not persuaded by the Siegel and Miller declarations that the originally filed drawings in this application support the illustrations of the tail cap in Figures 5 and 6 of the pending drawings. In the first place, Figure 2 of the originally filed drawings merely shows a longitudinal section of the tail cap. This Figure, therefore, does not illustrate any surface portion of the back face of the tail cap in plan or elevation as in pending Figure 6. At best, original Figure 2 merely illustrates a line of the back face in the plane defining the longitudinal section. In addition, it does not follow from the mere fact that some portions of the flashlight may appear to be symmetrical that the tail cap is symmetrical throughout. In this regard, it is quite evident that designs for flashlights or similar articles are not necessarily symmetrical throughout their

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entire longitudinal extent. Indeed, there is nothing to prohibit appellant's flashlight design from having asymmetrical portions as well as symmetrical portions.

Furthermore, and more importantly, appellant's position is fatally flawed in that even if it is assumed arguendo that the flashlight is symmetrical throughout its longitudinal extent, the back face Bd 10 of the tail cap may very well have indentations (such as the cavities Bd 12) or surface marks located symmetrically on opposite sides of and in spaced relation to the longitudinal plane containing the longitudinal axis of the flashlight and medially intersecting the tab 29. As a result, those indentations, cavities or surface markings would not be seen in the longitudinal section of original Figure 2.

In the final analysis, the illustration of the tail cap back face Bd 10 as being planer throughout its entire area as shown in Figure 6 of the pending drawings is just one possibility of two or more possibilities. However, the fact that a designer of ordinary skill might realize from a review of a disclosure that something is possible is not a sufficient indication that the inventor had possession of that something at the time the application was filed. See In re Barker, 559 F.2d 588, 591, 194

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USPQ 470, 472 (CCPA 1977). The fact remains that the originally filed drawings are silent as to which of the various possibilities is to be selected for illustrating the rear elevation of the tail cap.

Our next consideration concerns the flashlight barrel which is defined by an intermediate textured portion (identified by the reference character Bd 15 in appendix VII of the first Board decision) and what appears to be two cylindrically smooth untextured front and rear end portions at opposite ends of the intermediate textured portion. Although the textured pattern for the intermediate barrel portion (Bd 15) in the pending drawings now appear to more closely resemble the textured pattern of the intermediate barrel portion in the originally filed drawings, there still remains certain noticeable differences between the barrel illustrated in the pending drawings and the originally filed drawings.

In the first place, in Figures 1 and 8 of the originally filed drawings, two closely spaced circles are shown in the region where the tail cap meets the cylindrically smooth rear end portion of the barrel. In contrast, only one circle is shown in

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this region in Figures 1-3 and 5 of the pending drawings. This variance is not supported by the drawings as filed.

Furthermore, the axial proportions of the barrel portions shown in Figures 1-3 and 5 of the pending drawings do not agree with proportions of corresponding barrel portions shown in Figures 1 and 8 of the originally filed drawings.⁴ In particular, in Figure 1 of the originally filed drawings, the axial length of the cylindrically smooth rear end barrel portion is shown to be about equal to the axial length of the exposed section of the cylindrically smooth front end barrel portion lying axially between the forward end of the textured intermediate barrel portion and the rear end of the flashlight head. In contrast, in Figures 2, 3 and 5 of the pending drawings, the axial length of the cylindrically smooth rear end barrel portion is shown to be considerably greater than the axial length of the exposed section of the cylindrically smooth front end barrel portion lying axially between the forward end of the textured intermediate

⁴ The illustration of the flashlight in Figure 1 of the pending drawings is also at a variance with the illustration of the flashlight in Figures 2, 3 and 5 of the pending drawings. In particular, the axial length of the cylindrically smooth rear end portion of the barrel is shown in Figure 1 of the pending drawings to be only slightly greater than the axial length of the cylindrically smooth front end portion of the barrel. In contrast, the axial length of the cylindrically smooth rear end barrel portion is shown in Figures 2, 3 and 5 of the pending drawings to be considerably greater than the axial length of the cylindrically smooth front end barrel portion. Correction of this variance is in order in the event of further prosecution before the examiner.

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barrel portion and the rear end of the flashlight head. There is no support in the drawings as filed for this variance.

In addition, in Figure 1 of the originally filed drawings, the axial length of the textured intermediate barrel portion is shown to be more the four times greater than the axial length of the cylindrically smooth rear end barrel portion between the textured barrel portion and the tail cap. In contrast, in Figures 1-3 and 5 of the pending drawings, the axial length of the textured intermediate barrel portion is shown to be less than three times the axial length of the cylindrically smooth rear end barrel portion between the textured barrel portion and the tail cap.

Furthermore, the front elevation of the flashlight shown in Figure 4 of the pending drawings is not supported by the originally filed drawings. In this regard, Figures 2 and 3 of the originally filed drawings show shoulders in the rim extending from the outer periphery of the head to the lens of the flashlight. These shoulders are not illustrated in Figure 4 of the pending drawings. They appear to be correctly shown as concentric circles in original Figure 4 of appellant's companion application Serial No. 411,576.

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With regard to the issue concerning the deletion of the parting line (indicated by the reference character Bd 1 in appendix III of the first Board decision) in the flashlight head as shown in Figure 1 of the originally filed drawings, the issue is (1) whether the profile of the head in Figures 2, 3 and 5 of the pending drawings is the same as the profile of the head in Figures 2 and 3 of the original drawings and, if so, (2) whether the juncture between the cylindrical portion of the head (marked Bd 4 in appendix IV of the first Board decision) and the tapered portion of the head (marked Bd 5 in appendix IV of the first Board decision) is sharp enough to warrant a parting line.

Both the Siegel and Miller declarations, which were filed subsequent to the first Board decision, state that the shape of the flashlight head shown in the pending drawings is the same as the shape of the head shown in Figures 2 and 3 of the original utility application drawings and, hence, in Figures 2 and 3 of the drawings as originally filed in the instant application. The examiner has not refuted this evidence. Therefore, the first part of the issue stated supra must be answered in the affirmative based on the evidentiary record before us.

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With regard to the second part of the issue stated supra, both the Siegel and Miller declarations state that the juncture between the cylindrical and tapered head portions in Figures 2 and 3 of the originally filed drawings is curved rather than angled or sharp. This much was acknowledged in the first Board decision. The Siegel and Miller declarations go on to represent that the juncture between the cylindrical and tapered head portions is sufficiently curved to make it incorrect to show a parting line on the surface of the flashlight head. Both of these declarations additionally state that Figure 1 of the originally filed drawings, which shows the parting line, is inconsistent with shape of the flashlight head shown in Figures 2 and 3 of the originally filed drawings. The examiner has not refuted any of these statements in the Siegel and Miller declarations.

Based on the evidentiary record before us, Figure 1 of the pending drawings corresponds to the variation of the shape of the flashlight head shown in Figures 2 and 3 of the originally filed drawings. The illustration of the flashlight head without the parting line as shown in Figure 1 of the pending drawings is therefore common to and thus supported by subject matter as originally filed, namely Figures 2 and 3 of the originally filed drawings. See Daniels, 144 F.3d at 1457, 46 USPQ2d at 1791.

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For these reasons, the omission of the parting line from the flashlight head cannot be a basis for supporting the rejection based on the description requirement in the first paragraph of § 112. Nevertheless, each of the other differences between the pending drawings and the originally filed drawings as discussed supra does, by itself, constitutes an adequate basis for sustaining the examiner's rejection of the appealed claim under the first paragraph of § 112.

Accordingly, we will sustain the examiner's rejection of the appealed claim under the first paragraph of § 112. In doing so, we are not unmindful of appellant's allegation of commercial success on page 2 of the main brief. In support of this allegation, appellant quotes a laudatory statement by a District Court Judge in a civil action involving a company which appears to be associated with appellant. This quoted statement, even if accepted as being competent evidence, does not identify the "invention" involved in the civil action.

Moreover, there is no representation that the invention mentioned in the Judge's statement is appellant's design as opposed to an invention in one of appellant's utility patents. Commercial success of a utility invention, without more, is not

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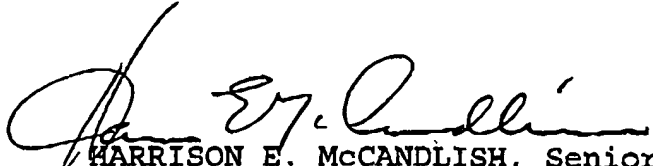
tantamount to commercial success of appellant's design. More importantly, we are aware of no authority, and appellant has cited none, which indicates that commercial success, which is evidence of unobviousness, is applicable to overcome a rejection based on the description requirement in the first paragraph of § 112. Finally, we are aware of no authority, and appellant has cited none, holding that evidence of commercial success would justify the relaxation of the statutory requirements for granting a patent.

The examiner's decision rejecting the appealed claim is affirmed.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED


HARRISON E. McCANDLISH, Senior)
Administrative Patent Judge)


LAWRENCE J. STAAB)
Administrative Patent Judge)


JEFFREY V. NASE)
Administrative Patent Judge)

) BOARD OF PATENT
)
) APPEALS AND
)
) INTERFERENCES
)

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APPENDIX

Figure 1 is a front perspective view of a miniature flashlight showing my new design;

Figure 2 is a side elevational view thereof, the other side being a mirror image;

Figure 3 is a bottom plan view thereof; and

Figure 4 is a front elevational view thereof; and

Figure 5 is a top plan view thereof; and

Figure 6 is a rear elevational view thereof.